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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/983,318	01/15/1998	SEPPO HUOTARI	PM244515/296	1286

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EXAMINER

GESESSE, TILAHUN

ART UNIT

PAPER NUMBER

2685

DATE MAILED: 02/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

08/983,318

Applicant(s)

SUOTARI, SEPPO

Examiner

Tilahun B Gesesse

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 7-19 is/are pending in the application.
- 4a) Of the above claim(s) 1,3-5 and 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/22/02 has been entered.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 16 recites the limitation "speech connection establishing between a calling subscriber and a called subscriber in a mobile communication system", the specification states that a signaling technique unrelated to speech connection or set up. There is no support to applicant's claim limitation in the specification as originally filed. Therefore, in this regard, it is a new matter introduced in the amendment.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 11-12,14-16 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Ericsson et al (us 5,956,637).

As to claim 11,14, Ericsson et al disclose a method of transmitting an identity of a calling subscriber (1A) to a called subscriber (1 B) , wherein the called subscriber is a mobile subscriber in a mobile communication system comprising switching centers (1107 and 1108) for establishing a speech connection between the calling subscriber and a mobile station assigned to the called subscriber,(fig.11) wherein one of the switching centers (1108)is associated with the called subscriber(1B), (col.12 lines 11-26) the method comprising:

- Storing permanent sub subscriber data in a home local register and
- Storing temporary subscriber data in a visitor location register; (col.6 lines 29-41) and
- Transmitting the identity of the calling subscriber to the switching center associated with the called subscriber in connection with a request for request for routing information (col.17 lines 14-19).

As to claim 12 and 15, Ericsson et al disclose transmitting the identity of the calling subscriber to the switching center associated with the called subscriber via the home location register (col.17 lines 14-19)

As to claim 16, Ericsson et al disclose everything as explained above and furthermore Ericsson et al disclose a first interface (1105) toward a gateway switching center((1107) for receiving a request a connection between a calling and a called subscribers, (fig.11)

Ericsson et al disclose a second interface forward a home location register (1123 or 1124))for receiving an identity of the calling subscriber in connection with a request for routing information relating to the called subscriber; (fig.11) and

Ericsson et al disclose a third interface toward the called subscriber (1106) for establishing the requested speech connection between the calling subscriber and the called subscriber, (fig.11).

As to claim 18, Ericsson et al disclose everything as explained above and furthermore, Ericsson et al disclose a second interface toward a combination of a visitor location register plus mobile switching center or VMSC , for requesting routing information relating to the called subscriber and for transmitting the identity of the calling subscriber to said VMSC,(1108 and 1107), (fig.11).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 13, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ericsson et al in view of Maenpaa (5,600,705).

As to claim 13, 17 and 19, Ericsson et al differs in disclosing signaling technique of subscriber identity in a map provide roaming number. Maenpaa, however, discloses signaling the subscriber identity in a map provide roaming number, (col.2 lines 1-16, col. 7 lines 60-68. It would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the map provide roaming number of Ericsson with teaching of Maenpaa, in order to identify the roaming subscriber by roaming number and locate the area roaming the subscriber.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 11-19 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

***Any response to this action should be mailed to:***

*Commissioner of Patents and Trademarks*

*Washington, D.C. 20231*

***or faxed to:***

*(703) 308-6296, (for formal communications intended for entry)*

*Or:*

*(703) 305-9508 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")*

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington,  
VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Tilahun Gesesse whose telephone number is (703) 308-5873..  
The examiner can normally be reached on Monday-Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Edward F. Urban, can be reached on (703) 305-4385. The fax phone number for this  
Group is (703) 308-6306 or (703) 308-6296.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the Group receptionist whose telephone number is (703) 305-4700.

TBG

Feb. 9, 2002

*Tilahun Gesesse*

*Patent Examiner*

*Art Unit 2685*

  
EDWARD F. URBAN  
PRIMARY EXAMINER